

REMARKS

This is a full and timely response to the non-final Official Action mailed **September 16, 2008** (the “Office Action” or “Action”). Reconsideration of the application in light of the above amendments and the following remarks is respectfully requested.

Claim Status:

By the forgoing amendment, various claims have been amended. Additionally, original claims 2-4, 6 and 12-27 have been cancelled, and new claims 28-34 have been added. Thus, claims 1, 5, 7-11 and 28-34 are currently pending for further action.

35 U.S.C. § 112, second paragraph:

In the recent Office Action, claim 4 was rejected under 35 U.S.C. § 112, second paragraph. This rejection is rendered moot by the cancellation herein of claim 4.

Prior Art:

Claim 1, 5-13 and 15-27 were rejected under 35 U.S.C. § 103(a) over the combined teachings of Applicant’s Fig. 1 (“Allegedly Admitted Prior Art”) and U.S. Patent App. Pub. No. 2005/0289617 to Safadi et al. (“Safadi”). For at least the following reasons, this rejection should be reconsidered and withdrawn.

Claim 1 now recites:

A television signal processing and recording system for handling both digital and analog video signals, said system comprising:
an analog signal path comprising an analog tuner, a video decoder for converting an analog signal to a digital signal, and an encoder for compressing said digital signal output by said video decoder; and
a digital signal path comprising a digital tuner and a demultiplexer;

a connection for routing said compressed digital signal from said encoder of said analog signal path to said demultiplexer;
wherein said demultiplexer outputs a demultiplexed signal to either a decoder with output to a display device or a digital data storage device.

Support for the amendment to claim 1 can be found in Applicant's originally filed specification at, for example, Fig. 2 and the accompanying textual description.

In contrast, the combined prior art references fail to teach or suggest the claimed demultiplexer in a digital signal path with "a connection for routing said compressed digital signal from said encoder of said analog signal path to said demultiplexer." The cited prior art also fails to teach or suggest the claimed demultiplexer, "wherein said demultiplexer outputs a demultiplexed signal to either a decoder with output to a display device or a digital data storage device." This subject matter is entirely outside the scope and content of the cited prior art.

The Supreme Court recently addressed the issue of obviousness in *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727 (2007). The Court stated that the *Graham v. John Deere Co. of Kansas City*, 383, U.S. 1 (1966), factors still control an obviousness inquiry. Under the analysis required by *Graham* to support a rejection under § 103, the scope and content of the prior art must first be determined, followed by an assessment of the differences between the prior art and the claim at issue in view of the ordinary skill in the art. In the present case, the scope and content of the prior art, as evidenced by the AAPA and Safadi, did not include the claimed subject matter, particularly "a connection for routing said compressed digital signal from said encoder of said analog signal path to said demultiplexer; wherein said demultiplexer outputs a demultiplexed signal to either a decoder with output to a display device or a digital data storage device."

The differences between the cited prior art and the claimed subject matter are significant because the claimed subject matter provides features and advantages not known or available in the cited prior art. Consequently, the cited prior art will not support a rejection of claim 1 and its respective dependent claims under 35 U.S.C. § 103 and *Graham*.

Claims 2-4 and 14 were rejected under 35 U.S.C. §103(a) over the combined teachings of the AAPA, Safadi and U.S. Patent App. Pub. No. 2001/0042165 to Ikeda (“Ikeda”). This rejection is moot due to the cancellation herein of claims 2-4 and 14. However, Applicant wishes to note that even though Ikeda teaches a digital video input section (13) (Action, p. 12), Ikeda clearly does not teach or suggest the claimed demultiplexer including “a connection for routing said compressed digital signal from said encoder of said analog signal path to said demultiplexer; wherein said demultiplexer outputs a demultiplexed signal to either a decoder with output to a display device or a digital data storage device.” Therefore, Ikeda cannot remedy the deficiencies of the other cited references as outlined above.

The newly added claims are thought to be patentable over the prior art of record for at least the same reasons given above with respect to the original independent claims. Therefore, examination and allowance of the newly added claims is respectfully requested.

Conclusion:

In view of the foregoing arguments, all claims are believed to be in condition for allowance over the prior art of record. Therefore, this response is believed to be a complete response to the Office Action. However, Applicant reserves the right to set forth further arguments in future papers supporting the patentability of any of the claims, including the separate patentability of the dependent claims not explicitly addressed herein. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed.

The absence of a reply to a specific rejection, issue or comment in the Office Action does not signify agreement with or concession of that rejection, issue or comment. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment. Further, for any instances in which the Examiner may seek to rely on Official Notice, Applicants expressly do not acquiesce to the taking of Official Notice, and respectfully request that the Examiner provide an affidavit to support the Official Notice taken in the next Office Action, as required by 37 CFR 1.104(d)(2) and MPEP § 2144.03.

If the Examiner has any comments or suggestions which could place this application in better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

If any fees are owed in connection with this paper that have not been elsewhere authorized, authorization is hereby given to charge those fees to Deposit Account 18-0013 in the name of Rader, Fishman & Grauer PLLC.

Respectfully submitted,

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/Steven L. Nichols/

Steven L. Nichols

Registration No. 40,326

Steven L. Nichols, Esq.
Managing Partner, Utah Office
Rader Fishman & Grauer PLLC
River Park Corporate Center One
10653 S. River Front Parkway, Suite 150
South Jordan, Utah 84095

(801) 572-8066
(801) 572-7666 (fax)